

48



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SQUIRE, SANDERS & DEMPSEY L.L.P.			LUDWIG, MATTHEW J	
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2178  
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Please find below and/or attached an Office communication concerning this application or proceeding.

48

# Office Action Summary

Application No.

09/436,973

Applicant(s)

PENNELL ET AL.

Examiner

Matthew J. Ludwig

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,7-35 and 37-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,7-20, 22-30, 32-35, 37-42, 44-81 is/are rejected.
- 7) ☒ Claim(s) 21,31 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: Amendment A filed 8/14/03. The application claims benefit of a provisional application 60107791 filed 11/10/98.
2. Claims 2, 3, 5, 7-35, and 37-81 are pending in the case. Claims 2, 33, 66-68, 75, 80, and 81 are independent claims.
3. The rejection of claims 2, 5, 7, 9, 10-13, 15-21, 24-27, 34, 35, 37-39, 43, 46, 50-55, 58-63, and 65-67 under 35 U.S.C 102(e) as being unpatentable over Kaply has been withdrawn pursuant to the Applicant's Amendment. The above-mentioned claims are now rejected under 35 U.S.C 103(a) as being unpatentable over Kaply in view of Light.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 5, 7-23, 25-27, 29, 34, 35, 37-39, 44-63, 65-68, 73, 74-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaply, U.S. Patent Number 6,112,215 filed (9/24/98) in view of Light et al., U.S. Patent Number 6,192,380 filed (3/31/98).

**In reference to independent claim 2,** Kaply teaches the steps of:

In the case of a global network such as the Internet, the present invention may be operatively associated with the Internet browser or even from a component of the browser. The method of receiving a request for user data is demonstrated with a program for developing and presenting a menu representative of a set of repetitively needed data entries within a web

Art Unit: 2178

browser environment. The menu offers the user the opportunity to retrieve user data corresponding to the user. The reference further discloses a menu, which is inherently executed by program code, for the user to enter at least a portion of the user data into the electronic form. See column 2, lines 14-18 and column 3, lines 5-10.

The reference does not explicitly disclose the updating of user data with user data from a second location; however, Light teaches a method that scans a form to determine whether there are any spaces that were filled in by the user and not the fill-in unit. The learning subunit then extracts the tags and data associated and passes them to the learning subunit. Light suggests a technique for update the user data with user data from a second location. It would have been obvious to one of ordinary skill in the art, having the teachings of Kaply and Light before him at the time the invention was made to modify the form filling methods taught by Kaply to include the updating methods of Light, because it would give the system the ability to learn from user input for an enhanced form-filling method.

**In reference to dependent claim 3, Kaply teaches:**

Routines are developed for making the menu displayable, i.e. super imposable over any selected displayed interface screen, to thereby link the menu to the display screen so that the entries may be transferred to fields in the screen or page. See column 6, lines 8-15. Kaply does not explicitly teach program code, which includes a script corresponding to the electronic form. However, Light discloses a form that includes a hypertext markup language tag such as "form", or "input type," indicating that it is a form or that it requires user input. See column 3, lines 1-5. The program code mentioned in Light provides a proficient architecture for the addition of script within electronic forms. Therefore, it would have been obvious to modify the form fill-in

Art Unit: 2178

methods of Kaply and applied the HTML techniques of Light to provide a proficient driven menu for use with electronic forms.

**In reference to dependent claim 5, Kaply teaches:**

The program of the present invention may conveniently be incorporated into a browser program whereby, as pages of Internet are brought up, the database of the present invention may be accessed for the making of repetitive data entries. See column 6, lines 10-20.

**In reference to dependent claim 7, Kaply teaches:**

Kaply discloses requested entries, which are frequent or repetitive entries, known or believed to be in the database of such entries. The menu of the items in the database is brought up, and displayed whereby the page on the screen is linked to the database through the menu, so that items from the menu may be selected and transferred to the page as data entries. See column 6, lines 20-36. The limitations of "obtaining the program code includes retrieving the program code" are met by the program code utilized to access the menu and presenting the user direct access to data entries.

**In reference to dependent claim 8, Light discloses:**

The computer system further comprises a main memory, a dynamic storage device for storing information and instructions to be executed (compare to "the program code is stored on a user computer"). See column 2, lines 27-30. The automatic web based form fill-in methods of Light demonstrate the form recognition techniques necessary for improving recognition in form filling by storing program instructions on a users computer and would have provided Kaply with the added benefit of storing program instructions on a user computer, which would recognize various forms within a network environment. Therefore, it would have been obvious to one of

Art Unit: 2178

ordinary skill in the art, having the teachings of Kaply and Light before him at the time the invention was made, to modify the form fill-in techniques taught by Kaply to include the stored program code of Light, because it would have provided enhanced capabilities of form filling by allowing the user to recognize the specific data for placement into a form.

**In reference to dependent claim 9, Kaply teaches:**

Some typical major elements connected to the Internet are user network connected through server at a node. See column 4, lines 30-36.

**In reference to dependent claim 10, Kaply teaches:**

The user is being prompted for repetitive information as the computer name, user name and a licensing key. Menu is brought up and appropriate selections are made and entered into fields through to provide the completed initial display screen. See column 5, lines 40-45.

**In reference to dependent claim 11, Kaply teaches:**

The menu of the present invention representative of the items of the database may be superimposed on any interface display screen requiring data entries. See column 5, lines 50-60. The reference discloses the retrieval of data from designated databases; however, Kaply does not explicitly disclose user data being retrieved. Light discloses user data being retrieved from a database by utilizing the matching unit and evaluation unit. (See column 4, lines 1-5. It would have been obvious to one of ordinary skill in the art, having the teachings of Kaply and Light before him at the time the invention was made, to modify the database techniques taught by Kaply to include the inclusion of user data of Light, because it would have given the user added access methods for an enhance form-filling method.

Art Unit: 2178

**In reference to dependent claim 12, Kaply teaches:**

Until required by the computer system, the program instructions may be stored in another readable medium. See column 6, lines 45-55. Kaply does not explicitly disclose user data being retrieved. Light discloses user data being retrieved from a database by utilizing the matching unit and evaluation unit. (See column 4, lines 1-5. It would have been obvious to one of ordinary skill in the art, having the teachings of Kaply and Light before him at the time the invention was made, to modify the database techniques taught by Kaply to include the inclusion of user data of Light, because it would have given the user added access methods for an enhanced form-filling method.

**In reference to dependent claims 13, Kaply teaches:**

In browsing the Internet, accessing particular databases and arranging to be billed for Internet services, it may be seen that much of this information is repetitive and needs to be entered again and again, many times. The limitations “user data includes contact information” and “user data includes credit information” are met by the reference demonstrating the user being billed for Internet services. See column 5, lines 20-26.

**In reference to dependent claims 14 & 22, Light discloses,**

A displayed label associated with the entry blank may be copied. Thus, the text “My credit card number is”, is copied, and the tag “credit card number” is extracted from the text. See column 5, lines 50-60. Light demonstrates data entries within a form that would require the user to input credit information. Kaply discloses data entries, which contain user information within a form, but does not explicitly teach supplying credit information. It would have been obvious to one of ordinary skill in the art, having the teachings of Kaply and Light before him at the time

Art Unit: 2178

the invention was made, to modify the data entry methods taught by Kaply, to include the tag extraction techniques of Light, because it would have provided Kaply the added benefit or a tag extraction method related to credit information and a fill-in unit to supply the necessary credit information for an enhanced form filling process within a network environment.

**In reference to dependent claim 15, Kaply teaches:**

The user is being prompted for repetitive information as the computer name, user name and a licensing key. Here again, menu is brought up and appropriate selections are made and entered into fields through to provide the completed initial display screen. See column 5, lines 39-45.

**In reference to dependent claim 16, Kaply teaches:**

The user points out and transfers appropriate selected data entries from the menu to appropriate fields. The information transferred from the database into the selected appropriate data entry fields in the display screen by any convention means, e.g. "drag and drop". See column 5, lines 34-38 and column 5, lines 55-60.

**In reference to dependent claim 17, Kaply teaches:**

The database may be continuously updated by the user and customized to the users own needs. Then, a displayable menu is created representative of each database entry. See column 6, lines 1-10.

**In reference to dependent claim 18, Kaply teaches:**

The database may be continuously updated by the user and customized to the users own needs. Then, a displayable menu is created representative of each database entry. See column 6, lines 1-10.



**In reference to dependent claim 19, Kaply teaches:**

A program for developing and presenting a menu representative of a set of repetitively needed data entries. See column 3, lines 5-10.

**In reference to dependent claim 20 & 21, Kaply teaches:**

The user points out and transfers appropriate selected data entries from the menu to appropriate fields through to produce the completed data entry screen. See column 5, lines 34-40. The reference demonstrates the utilization of multiple entries for each data field on a pull down list. Kaply does not explicitly teach multiple entries for each data field on a pull down list; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the menu-driven list taught by Kaply and utilized multiple entries for any of the fields shown in Figure 4 to give the user several options for a enhanced form-filling method.

**In reference to dependent claim 23, Light discloses:**

The learning subunit scans the form, and determines whether there are any spaces that were filled in by the user, not the fill-in subunit (compare to “*multiple entries for each data field have been previously supplied by the user*”). See column 4, lines 25-30. The reference demonstrates the specific form fields filled in by a user. Kaply teaches replacing repetitive entries with entries from a menu, but does not explicitly teach multiple entries for each data field previously supplied by the user. It would have been obvious to modify the data entry methods of Kaply to include the user-supplied supplied data entries as taught by Light, because it would have offered Kaply the added benefit of learning new data previously supplied or filled in by the user for a proficient form-filling method.

Art Unit: 2178

**In reference to dependent claims 25-27, Kaply teaches:**

The user points out and transfers appropriate selected data entries from the menu to appropriate fields. The information transferred from the database into the selected appropriate data entry fields in the display screen by any convention means, e.g. "drag and drop". See column 5, lines 34-38 and column 5, lines 55-60.

**In reference to dependent claim 29, Light discloses:**

The user is requested to enter further tags associated with the data. Thus, when the user enters his or her first name, in response to a tag asking for a "first name", the user may add other tags, such as "given name", etc. See column 4, lines 47-52. The reference demonstrates various user data sets, which correspond to the same user. Kaply teach multiple data entries within a form-filling environment, but does not explicitly teach the selection of a user data set from multiple user data sets. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kaply to include the multiple data variations of Light, because it would have provided Kaply with an added benefit of a range of data to choose from when utilizing the form-filling techniques as taught by Light.

**In reference to claims 34, 35, the limitations of the claims are the system and program code for carrying out the methods of claim 2, 3, and are therefore rejected under similar rationale.**

**In reference to dependent claims 37-39, 50-52, 58-63, 65-67 the limitations of these claims are the system for carrying out the methods of claims 5-7, 13-19, and are rejected under the same rationale.**

**In reference to dependent claims 44-49, the limitations of the claims recite similar limitations to that of claim 8, 11, 12 and therefore are rejected under similar rational.**

Art Unit: 2178

**In reference to dependent claims 53-57**, the limitations of the claims recite similar limitations to that of claims 20, 21, 22 & 23 and are therefore rejected under similar rational.

**In reference to independent claim 68**, Light discloses:

When the user presses enter, or otherwise indicates that the form is completely filled in (compare to “receiving a request form a client”), the learning subunit scans the forms, and determines whether there are any spaces that were filled in by the user. The learning subunit determines whether the data already exists in the database. If it does, the database adding unit adds the new tag to the list of tags associated with the information in the database. If the data is not in the database, the database-adding unit adds the new data and the new tag to the database (compare to “the program code unit being configured to enter data into an electronic form; and initiating transmission of the program code unit to the client”). See column 4, lines 15-30. The reference does not explicitly disclose entering the data establish by the learning subunit into an electronic form; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Light to include the step of entering the data that was saved in a database into the electronic form for the added benefit of an efficient form-filling technique.

**In reference to dependent claim 73**, Light discloses:

Once the tag recognition unit has extracted a tag, it passes the tag to the matching. The matching unit searches in the database for a similar tag. See column 3, lines 60-65. The reference demonstrates storing user data corresponding to a user through the utilization of tags.

Art Unit: 2178

**In reference to dependent claim 74**, Light discloses:

The user may activate the fill-in process by pressing a key, a key combination, a left mouse button, or a similar activation mechanism. See column 5, lines 45-50. The reference demonstrates the user requesting user data and initiating the transmission of the user data through the use of the mouse.

**In reference to claims 75-81** the limitations of the claims recite similar limitations to that of claims 68, 73, 74, and 68 are therefore rejected under similar rationale.

6. **Claims 28 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaply, U.S. Patent Number 6,112,215 filed (9/24/98) in view of Light et al., U.S. Patent Number 6,192,380 filed (3/31/98) and in further view of Bogdan U.S. Patent Number 6,249,284 filed(4/1/98).**

**In reference to dependent claim 28**, Bogdan discloses:

A user would enter data in one data entry field at a time while the viewer control automatically moved the cursor to each successive data entry field as each prior data entry field was satisfied. The reference demonstrates the automatic advancement of a cursor within a form-filling environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the data entry methods of Kaply and included the technique discloses in Bogdan, because it would have provided the user an efficient way of filling in form fields.

**In reference to dependent claim 64**, the claim recites similar limitations to those of dependent claim 28, and therefore is rejected under the same rationale.

**7. Claims 30, 32, 33, and 40-42, and 69-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaply, U.S. Patent Number 6,112,215 filed (9/24/98) in view of Light et al., U.S. Patent Number 6,192,380 filed (3/31/98) and in further view of Gupta et al., U.S. Patent Number 6,199,079 filed (3/20/98).**

**In reference to dependent claim 30**, Kaply and Light do not teach comparing Uniform Resource Locators (URLs) of a visited site against a set of URLs for which program code is supposed to be available; however, Gupta discloses methods of associating URLs with form identifiers to determine one or more corresponding matching patterns. The reference demonstrates the utilization and comparisons of URLs as a proficient technique in automatic form filling. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kaply to include the URL methods of Gupta, because it would have given the user the added benefit of efficiently locating vendor's sites using URL relationships and automatically filling in required forms.

**In reference to dependent claims 32 and 33**, the claims recite similar limitations to those of claim 30, and are therefore rejected under the same rationale.

**In reference to dependent claims 40-42**, the claims recite the system for carrying out the methods of claim 30, and are therefore rejected under the same rationale.

**In reference to dependent claim 69-72**, the claims recite similar limitations to that of claim 30-33, and are therefore rejected under the same rationale.

***Allowable Subject Matter***

8. Claims 24, 31 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 8/14/03 have been fully and carefully considered but they are not persuasive.

It is respectfully noted that applicant's incorporation of new limitations into independent claim 2, changes the scope of the claim when interpreted as a whole. Therefore, the instant rejections have been adjusted accordingly.

Applicant argues on pages 11 & 12 of the amendment that the reference does not teach or suggest the limitations of independent claim 2. Applicant further states that Kaply does not disclose the updating of user data with user data from a second location. However, the learning unit and the adding unit as taught by Light suggest the updating of user data from two separate locations. Because the claim limitation are to be given their broadest reasonable interpretation within the scope of the art, the form-scanning techniques of Light provide a proficient means of analyzing a form, checking to see whether a database holds similar content within the form, and updates the database with content if the user information is not found within the database. The examiner notes, that (as presently claimed) the Light reference suggests the updated methods within the claim's limitations. The combination of the two references provides a reasonable interpretation of the claimed limitations when read as a whole.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

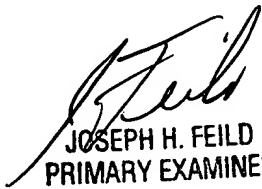
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 703-305-8043. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ML  
December 3, 2003



JOSEPH H. FEILD  
PRIMARY EXAMINER